



Patricia Lewis
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Election
8-8-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Herbert Gropp et al.

Serial No: 09/476,521

Art Unit: 3682

Filing Date: January 3, 2000

Title: BUILT-UP CAMSHAFT

Examiner: Vinh T. Luong

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July 26, 2000

RUM212R6

RESPONSE TO RESTRICTION REQUIREMENT

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

SIR:

This is in response to the Office Action mailed July 3, 2000 setting a shortened statutory period of one month to expire on August 3, 2000. Applicants petition that, if required, the time for response be extended and the corresponding fee be charged. Applicants further respectfully request that this response be accepted as a bona fide effort to meet any potential response requirements outstanding and due.

REMARKS

The Office Action mailed on July 3, 2000 provides for a restriction requirement under 35 U.S.C. 121 placing

the claims into the following groups:

I. Claims 1-7, drawn to a camshaft, classified in class 74, subclass 567.

II. Claim 8, drawn to a method of building a camshaft, classified in class 29, subclass 888.1.

Pursuant to the requirement for restriction, Applicants provisionally elect the invention classified in group I with claims 1 to 7 for purposes of initial examination.

3. Restriction to one of the following inventions is required by the Office Action under 35 U.S. C. 121:

I. Claims 1-7, drawn to a camshaft, classified in class 74, subclass 567.

II. Claim 8, drawn to a method of building a camshaft, classified in class 29, subclass 888.1.

The requirement is respectfully traversed. Applicant selects group I to be considered first in the examination process.

4. The inventions are distinct according to the Office Action, each from the other because inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown that: (1) the process as claimed can be used to make other and materially different product; or (2) the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, that the process as claimed can be used to make other and materially different product such as a crankshaft. Alternatively, the product as claimed can be made by another and materially different process such as high pressure deformation to joint the pipe, the cams and the bearing ring. See, e.g., applicant's evidence claims 6 and 7, and page 2 of applicant's specification.

Applicants respectfully disagree. The Office Action says that the method can be used to "make other and

materially different product such as a crankshaft". However claim 8 states specifically "for building a camshaft". Applicant respectfully submits that where a claim calls for building a camshaft, then the claim does not concern a crankshaft as alleged in the Office Action.

The Office Action further asserts that the product as claimed can be made by another and materially different process such as high pressure deformation to joint the pipe, the cams and the bearing ring.

Applicants do not understand this argument and consequently respectfully traverse the argument. Applicants do not understand how high pressure deformation can provide for example a pipe coated by a cement on an outer cylindrical surface as required according to the language of claim 7. Clarification as to the other and materially different process is respectfully requested.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification according to the Office Action, restriction for examination purposes

as indicated is proper.

Applicants disagree and respectfully submit that a single invention is presented by the applicants.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter according to the Office Action, restriction for examination purposes as indicated is proper.

Applicants urge that the showing of distinctness for the claims under consideration made in the Office Action is inadequate for issuing a restriction requirement.

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Applicants urge that the claims in group I and in group II refer to one and the same invention.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1. 143).

Applicants have set forth that they elect group I.


Further action on the merits is awaited.

All claims as presently submitted are deemed to be in form for allowance and an early notice of allowance is earnestly solicited.

Respectfully submitted,

Herbert Gropp et al.

By:



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Herbert Gropp et al.
Serial No: 09/476,521 Art Unit: 3682
Filing Date: January 3, 2000
Title: BUILT-UP CAMSHAFT
Examiner: Vinh T. Luong

August 2, 2000

Rum212T7

TRANSMITTAL LETTER

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

SIR:

Transmitted herewith for filing is:

<X> Response to Restriction Requirement dated July 26, 2000 (6 pages)

() Enclosed is a check to cover the fee in the amount of \$_____.

(X) The applicant hereby petitions the Commissioner of Patents and Trademarks to extend the time for response to any Office Action outstanding in the above captioned matter as necessary to avoid abandonment of the application. Please charge my deposit account No.11-0224 in the amount required to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to the above account.

(X) The Commissioner is hereby authorized to charge any fees under 35 U.S.C. 1.16, and 1.17, after a mailing of a Notice of Allowance under 35 USC 1.18 or any additional fees which may be required during the entire pendency of the application, or credit any overpayment, to Acct. No.11-0224. A duplicate copy of this sheet is enclosed. If and only if account funds should be insufficient, immediately contact our associate, Lisa Zumwalt, at (703)415-0579, who will pay immediately to avoid deprivation of rights.

() Please charge my Deposit Account No.11-0224 in the amount of \$_____. A duplicate copy of this sheet is enclosed.

A signature or signatures required for the above recited document(s) is (are) provided herebelow. Such signature(s) also provide(s) ratification for any required signature appearing to be defective in the above recited document(s).

Horst M. Kasper
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Reg. No. 28,559 Tel.(908)757-2839

Express Mail Certification:

I hereby certify that the correspondence attached hereto is being deposited with the USPS "Express Mail Post Office to Addressee" on the date indicated below and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231,

on.....² AUG 2000....."Express Mail Mailing Label No": *TB173618522 US*.....
Signature.....*Heppner*..... Date.....² AUG 2000.....

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